

Remarks

The preceding amendments and following remarks are submitted as a full and complete response to the Office Action issued on March 19, 2008. Claims 1, 3, 5, 6, 7, 8-12, 14, 15, 17 and 19 have been amended. Claim 23 has been added. Support for new claim 23 may be found, *inter alia*, in original claim 7. No new matter has been added. Currently, claims 1-23 are pending in this application.

Applicants note that the term "film" has been amended to "foil" throughout the claims. "Film" is a less than ideal translation of the German word "folie" from the international application. Importantly, the term "folie" refers to a self supporting layer, as is shown, *inter alia*, in paragraphs 0044 and 0051 of the present specification. Further, the term "folie" cannot refer to a coating applied as an aqueous solution or to a lacquer. Thus, the term "foil" has been chosen, because it is more accurate and excludes these concepts. No new matter is added.

Applicants submit that this amendment conforms with PCT practice, as well as USPTO practice. According to general PCT practice, an error within the translation of the international application may be rectified during the national phase before all designated Offices (PCT Applicant's Guide, Vol. II, no. 57). Additionally, the authorities of a Contracting State, such as the USPTO, may retroactively limit the scope of a granted patent to the extent that its scope has exceeded the scope of the original PCT application (Art. 46 PCT). Here, the term "film" may have exceeded the scope of the term "Folie" and thus the term "foil" is used.

With respect to USPTO practice, the amendment does not add new subject-matter to the disclosure, since the term "foil" is supported by numerous passages of the specification, such as 0044, 0051 and 0054-0057.

Claim 5 was rejected under 35 U.S.C. §112, second paragraph, for being allegedly indefinite. Applicants have amended claim 5 to recite that "the foils on different sides of the paper layer are under different strains." Applicants submit that claim 5, as amended, is not indefinite. Support for this amendment may be found, *inter alia*, at paragraphs 0034, 0055 of the present application and in the original German application. In particular, the term "stretch" was poorly translated in that the translation into English did not specify that the term "stretch" was used in the past tense. In view of the amendment to claim 5, Applicants submit that the rejection is moot and request that it be withdrawn.

Claim 6 was rejected under 35 U.S.C. §112, second paragraph, for being allegedly indefinite. Applicants have amended claim 6 to recite "annual plant fibers." Applicants submit that claim 6, so amended, is not indefinite because it is clear what type of fibers are used, namely, fibers from annual plants. Support for this amendment may be found, *inter alia*, in the original U.S. claims and in the phrase "Fasern von Einjahrespflanzen" in the corresponding PCT claim in German. Accordingly, Applicants submit that the rejection is moot and request that it be withdrawn.

Claim 7 was rejected under 35 U.S.C. §112, second paragraph, for being allegedly indefinite. Applicants have removed the objected term "polyamide fibers"

from claim 7, such that claim 7 only recites synthetic fibers. Accordingly, Applicants submit that the rejection is moot and request that it be withdrawn.

Claims 8, 9 and 12 were rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Applicants have amended the element "paper ply" to "paper layer." Applicants submit that the term "paper layer" is definite. Accordingly, Applicants submit that the rejection is moot and request that it be withdrawn.

Claim 12 was rejected under 35 U.S.C. §112, second paragraph, for being allegedly indefinite. Applicants have replaced the phrase "to form a total information" with "to form a security feature configured for self authentication." Support for this amendment may be found, *inter alia*, at paragraphs 0070, 0071, 0095 and 0096, along with figures 7 and 8. Applicants submit that claim 12, as amended, is not indefinite. Accordingly, Applicants submit that the rejection is moot and request that it be withdrawn.

Claims 1-3, 7-10, 13-15, 20 and 22 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,868,902 to Howland et al ("Howland"). Applicants traverse the rejection and submit that claims 1-3, 7-10, 13-15, 20 and 22 recite subject matter not disclosed by Howland.

Applicants respectfully note that Howland is the national U.S. application of WO 96/28610, which was discussed and distinguished from the present invention in the introduction of the present application. See paragraph 0005.

Claim 1, from which claim 2-23 depend, recites a security paper for producing value documents, including a creasable, foldable, multilayer substrate largely having a feel and sound of paper and comprising at least one paper layer coated with foil on both sides all over, characterized in that at least the foil is equipped with at least one security feature.

In contrast to the claimed invention, Howland describes applying a coating to paper in the form of an aqueous dispersion. Howland, col. 2, Ins. 55-56; col. 5, Ins. 44-45; col. 6, Ins. 27-28; col. 7, Ins. 5-6; col. 7, Ins. 48-49; col. 8, Ins. 22-23 and col. 9, Ins. 7-8. No matter how the coating of Howland dries, the coating cannot be a foil, because, at the least, it is not self-supporting. Thus, Howland does not disclose each and every element of claim 1, from which claims 2-3, 7-10, 13-15, 20 and 22 depend. Applicants respectfully request that the rejection be withdrawn, and claims 1-3, 7-10, 13-15, 20 and 22 be passed to issuance.

Claims 4-6, 16 and 21 were rejected under 35 U.S.C. §103(a) as being obvious over Howland in view of Haylock (Paper, "Its making, merchenting and usage"). Applicants traverse the rejection and submit that claims 4-6, 16 and 21 recite features not disclosed or suggested by the combination of Howland and Haylock.

Claims 4-6, 16 and 21 depend from claim 1, and thus are allowable over Howland for at least the reasons above. Haylock fails to cure these deficiencies because Haylock is concerned with foils. Applicants respectfully request that the rejection be withdrawn, and claims 4-6, 16 and 21 be passed to issuance.

Claim 7 was rejected under 35 U.S.C. §103(a) as being obvious over Howland in view of U.S. Pat. Pub. 2003/0059636 to Nigam. Applicants traverse the rejection and submit that claim 7 recites features not disclosed or suggested by the combination of Howland and Nigam.

Claim 7 depends from claim 1, and thus is allowable over Howland for at least the reasons above. Nigam fails to cure these deficiencies because Nigam is merely directed to sizing paper and is not concerned with foils. Applicants respectfully request that the rejection be withdrawn, and claim 7 be passed to issuance.

Claims 5, 11, 12 and 17-19 were rejected under 35 U.S.C. §103(a) as being obvious over Howland in view of U.S. Pat. Pub. 2002/0022112 to Hoeppner et al. ("Hoeppner"). Applicants traverse the rejection and submit that claims 5, 11, 12 and 17-19 recite features not disclosed or suggested by the combination of Howland or Hoeppner.

Claims 5, 11, 12 and 17-19 depend from claim 1 and thus are allowable over Howland for at least the reasons above. Hoeppner fails to cure these deficiencies because Hoeppner is concerned with plastic cards, not creasable foldable security paper. Additionally, one of ordinary skill in the art would not combine Howland with Hoeppner, because Hoeppner is in a different field. In particular, Hoeppner is directed exclusively towards the production of cards including a plastic coating which permits subsequent personalization of the respective cards by printing, laser, embossing or the like.

(Hoeppner, claims 5-7 and paragraphs 0016, 0026, 0032, 0038, 0048, or in particular 0055).

Even if one were to coat a piece of paper as taught by Hoeppner, one would end up with a security card, since it is definitely not possible to maintain the properties of creasability and foldability as well as the feel and sound of paper after having applied a first plastic coating to both sides of the paper layer and, after printing the same in order to apply further security features, having applied additional covering films or composite covering films on both sides of the already covered substrate (Hoeppner, paragraphs [0016] to [0020]). Applicants stress that the plastic coating of Hoeppner is embossable, because embossing requires material that can be raised to create a design. One of ordinary skill in the art would understand that to emboss a coating that will be subjected to further films would counteract the required properties of creasability and foldability. Therefore, Hoeppner actually teaches away from the presently claimed invention.

Applicants respectfully request that the rejection be withdrawn, and claims 5, 11, 12 and 17-19 be passed to issuance.

In view of the above, all objections and rejections have been sufficiently addressed. The Applicants submit that the application is now in condition for allowance and request allowance of claims 1-23 and that this application be passed to issue.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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